

1646



Patent  
Attorney's Docket No. 030708-035

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 14 2001

TECH CENTER 1600/2900

In re Patent Application of )  
Peter SONDEREGGER ) Group Art Unit: 1646  
Application No.: 09/403,724 ) Examiner: O. Chernyshev  
Filed: December 20, 1999 )  
For: NEUROTRYPSIN )

AMENDMENT/REPLY TRANSMITTAL LETTER

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and a check for ☐ \$55.00 (248) ☐ \$110.00 (148) to cover the requisite Government fee are also enclosed.
- ☐ Also enclosed is \_\_\_\_\_.
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$355.00 (279) ☐ \$710.00 (179) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted \_\_, on \_\_, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least \_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims	15	MINUS 20 =	0	× \$18.00 (103) =	
Independent Claims	14	MINUS 14 =	0	× \$80.00 (102) =	
If Amendment adds multiple dependent claims, add \$270.00 (104)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
<b>TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT</b>					

☐ A claim fee in the amount of \$\_\_\_\_\_ is enclosed.

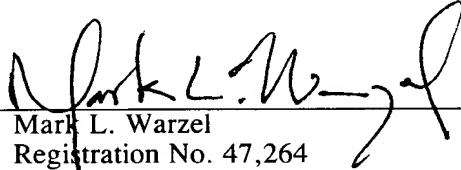
☐ Charge \$\_\_\_\_\_ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:

  
Mark L. Warzel  
Registration No. 47,264

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Date: June 11, 2001



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**RESPONSE TO RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In complete response to the Official Action (Restriction Requirement) mailed on May 9, 2001, in connection with the above-identified application, Applicants elect with traverse, Group I, Claims 16 and 19, directed to neurotrypsin and the first method of use of neurotrypsin.

In accordance with the species election requirement, Applicants further elect neurotrypsin of the human as the species.

Claims 16-30 are believed to read upon the above elected species. It is understood that the election of the above species is for search purposes and that, upon an indication of allowability of the elected species, the other species will also be examined.

Applicants respectfully traverse the Requirement for Restriction for at least the following reasons.

This application was filed, pursuant to 35 U.S.C. § 371, as a national stage application of PCT/IB98/00625. Therefore, the United States Patent and Trademark Office is required to follow PCT Rule 13.1 and 13.2 when considering unity of invention. As set forth in Section 1850 of the M.P.E.P., unity of invention exists when there is a technical relationship among the claimed inventions involving one or more special technical features. The claims of the subject application are so linked as to form a single general inventive concept. Thus, restriction is improper in the subject application.

In the Restriction Requirement, it has been asserted that Groups 1-13 do not relate to a single general inventive concept since they allegedly lack the same or corresponding special technical feature, namely the neurotrypsin protein of Group I (Claim 16). Applicants respectfully disagree for at least the following reasons.

Each of Claims 16-30 is based upon the compounds of formula I or II such that the same special technical feature forms part of all of these claims. As such, each of Claims 16-30 includes "one or more of the same or corresponding special technical features" of Claim 16, namely the compounds of formula I or II. Claims 16-30 should, therefore, be examined together since at least this same special technical feature is present in all the claims.

Moreover, even if appropriate reasons exist for requiring restriction, such a requirement should not be made unless there is a serious burden on the Examiner to examine all of the claims in a single application.

In this regard, it is respectfully submitted that the search required for Group I would be substantially co-extensive with the search for Groups 2 through 13 since all claims include the

compounds of formula I or II of Claim 16. A substantial overlap in the examination involved for the thirteen (13) groups is therefore present such that the claims are best examined together in the same application.

Applicants further note that Claim 17 is also drawn to the neurotrypsin according to Claim 16. As described in Section 1850 of the M.P.E.P., unity of invention is only considered in relation to independent claims and not dependent claims. Since dependent Claim 17 contains all the features of Claim 16 and is in the same category of claim as Claim 16, i.e., a product, Claim 17 at a minimum should be grouped with Group I (Claims 16 and 19).

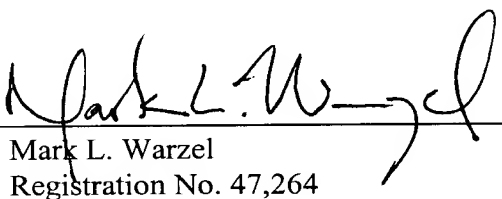
Accordingly, for at least the above reasons, withdrawal of the Requirement for Restriction and examination of pending Claims 16-30 together are respectfully requested.

If any issues remain outstanding, the Examiner is respectfully requested to contact the undersigned so that prosecution may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:

  
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Registration No. 47,264

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